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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/992,770	12/17/97	HACHIYA K	SONY-6900

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LMC1/0526

EXAMINER

VU, T

ART UNIT	PAPER NUMBER
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2756

DATE MAILED: 05/26/99

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
08/992,770

Applicant(s)  
Hachiya et al

Examiner  
Thong Vu

Group Art Unit  
2756



☒ Responsive to communication(s) filed on Dec 17, 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-24 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-24 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☒ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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## DETAILED ACTION

### *Drawings*

1. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

### *Specification*

2. For ease of referencing, the Applicant is requested to number the lines of the claims according to the number of the lines of the claims, not according to the line number of the page.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1-24

Claims ~~1-24~~ are rejected under 35 U.S.C. § 102 (b) as being unpatentable over Holt et al

[5,557,723]

As per claim 1, Holt et al disclose *a method for automatic controlling the sending and receiving Email ; an E-mail agent parameters controlling the behavior of an agent delivering an E-mail are appended to the main mail text having an appended main header, responsive to a sending command designating the sending of the E-mail, for sending to a counterpart of E-mailing of a user; the agent parameters are modified responsive to the contents of experiences reflecting the operating hysteresis for the agent; and an E-mail of a pre-set illustrative sentence is sent by said agent to the user based on said agent parameters* such as an electronic mail system

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provide user a customizable forms with the *appended header* [col 3 line 33]; *a pre-set illustrative sentence* or field object [col 4 line 13] agent parameters [col 6 line 14]. By this rationale claim 1 is rejected.

As per claim 2, Holt et al disclose *an illustrative sentence of an E-mail for sending is randomly selected from a plurality -of illustrative sentences classed or type, and pre- set depending on the contents of experiences acquired by said agent so that the selected sentence will be in a class in keeping with the contents of experiences acquired by said agent, the sentence so selected being voluntarily sent to the user* [col 6 line 27-62]. By this rationale claim 2 is rejected.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. § 103 as being unpatentable over Holt et al [5,557,723] in view of MacNaughton et al [5,796,393]

As per claim 3 Holt et al disclose *an effective period of said agent is set and an E-mail is voluntarily sent to the user on expiry of said effective period* [col 5 line 13-15]. However holt did not teach the time expired. MacNaughton et al, in his sytem for intergrating an On-line service communicty with Internet, disclosed *the period of time with time expired then the configurable*

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*action will take place* [MacNaughton col 12 line 1]. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate *the expired time* as taught by MacNaughton into Holt system in order to provide the user an option to control the activity on the electronic mail system. By this rationale claim 3 is rejected.

As per claims 4-24 contains the similar limitations set forth of method claims 1-3 .

Therefore, claims 4-24 are rejected for the same rationale set forth claims 1-3.

### ***Conclusion***

5. All claims are rejected.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- **Templeman et al** Document Processing Using Frame-Based Templates with Hierarchical Tagging [USP 5,845,303]

- **Grasso et al** Intranet-Based System with Method for Co-Active Delivery of Information to Multiple Users [USP 5,892,909]

- **Weber et al.** System for Email Messages Wherein The Sender Designates Whether The Recipient Replies or Forwards to Addresses Also Designated by The Sender [USP 5,878,230]

- **Kuma** . Transmitting Eletronic Mail Attachment Over A Network Using A Email Page [USP 5,781,901]

-**Beck et al** Method and Apparatus for Transmitting Eleetronic Mail Attachments with Attachment References [USP 5,903,723]

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**-Le Clercq** System For Automatic Notification of The Receipt of Messages in An Electronic Mail System [USP 5,138,653]

**-Ranalli et al** . Method and Apparatus for Automatically Sending and Receiving Modifiable Action Reports Via Email [USP 5,790,639]

**-Keller et al** System for Automatically Establishing A Link Between An Electronic Mail Item and A Remotely Stored Reference through A Place Mark Inserted into the Item[5,418,908]

**-Linstead et al** . Automatic Electronica Mail Notification of Database Events[5,548,753]

**-Hussey** . Electronic Mail Interface for A Network Server [USP 5,826,269]

**-Keyworth II et al** Group-Oriented Communications User Interface [USP 5,579,472]

**-Zachery** . Automatic Document Format Conversion in An Electronic Mail System Based Upon User Preference [USP 5,283,887]

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Thong Vu, whose telephone number is (703)-305-4643. The examiner can normally be reached on Monday-Thursday from 6:30AM- 4:00PM. The examiner can also be reached on alternate Fridays during the same hours.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Frank Asta*, can be reached on (703) 305-3817 or via e-mail addressed to [*Frank.Asta@uspto.gov*]. The fax number for this Group is (703) 308-6606 or 308-9731

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [**thong.vu@uspto.gov**].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

**Thong Vu**  
**703-305-4643**  
**May 12, 1999**

  
**FRANK J. ASTA**  
**SUPERVISORY PATENT EXAMINER**  
**GROUP 2700**